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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,433	04/06/2001	Thomas Brumm	112740-211	6084
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/827,433	BRUMM ET AL. <i>(G)</i>	
	<b>Examiner</b> David Odland	<b>Art Unit</b> 2662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>08/29/2002</u> .	6) <input type="checkbox"/> Other: ____.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites "...the first subscriber in the network element..." It is unclear how the first subscriber can be 'in' the network element.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1,2,3,4,6,10,11,12,14,17,18 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by the Admitted Prior Art discussed in the present application, hereafter referred to as APA.

Referring to claims 1,2,3,4,6,10,11,12,14,17,18 and 19, APA discloses a telecommunications system having a packet-switching communications network, comprising at least a first subscriber connected to the packet-switching communications network (terminals are connected to a packet switched network (see pages 2 and 3)) and a network element of a circuit-

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switching communications network connected to the packet-switching communications network using an interface unit (a gateway is connected between the packet switched network and a circuit switched network (see pages 2 and 3)). wherein first signaling information is transmitted between the network element and the first subscriber (user-channel-related signaling messages are transmitted between the terminal and the gateway that converts DSS1 messages to H.323/H.225 messages (see pages 2 and 3)), the first signaling information corresponding to a signaling standard of a circuit-switching communications network (the first signaling is DSS1 signaling which corresponds to circuit switched networks (see pages 2 and 3));

wherein the first signaling information corresponds to a DSSI signaling protocol (the first signaling is DSS1 signaling which corresponds to circuit switched networks (see pages 2 and 3));

wherein a portion of the first signaling information is converted into second signaling information using the interface unit and is transmitted as second signaling information between the interface unit and the first subscriber (user-channel-related signaling messages are transmitted between the terminal and the gateway that converts DSS1 messages to H.323/H.225 messages (see pages 2 and 3));

wherein the second signaling information corresponds to an H.323/H.450 signaling protocol (user-channel-related signaling messages are transmitted between the terminal and the gateway that converts DSS1 messages to H.323 messages (see pages 2 and 3));

wherein the interface unit converts the first signaling information of the network element into second signaling information, and further converts the second signaling information into the first signaling information (user-channel-related signaling messages are transmitted between the terminal and the gateway that converts DSS1 messages to H.323 messages and vice versa (see

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pages 2 and 3)), the first signaling information signaling information of the circuits switching communications network which can be converted the second signaling information (the first signaling is DSS1 signaling which corresponds to circuit switched networks (see pages 2 and 3));

wherein user data is transmitted using the network element when there is a connection between the first subscriber and at least one second subscriber (the system is used for transmitted information between subscribers since this is what the H.323 standard is for (see pages 2 and 3)).

wherein the user data is transmitted directly between the first and second subscribers using the packet- switching communications network when there is a connection between the first subscriber and the at least one second subscriber of the packet-switching communications network(the system is used for transmitted information between subscribers since this is what the H.323 standard is for (see pages 2 and 3)).

wherein a call number is assigned to the first subscriber in the network element, the first subscriber in the packet-switching communications network has a subscriber address, and wherein the assignment between the subscriber address and the call number is made using a control unit (the subscribers have addresses and the gatekeeper assigns addresses (see pafes 2 and 3));

wherein the packet-switching communications network is a data network which is based on an Internet protocol, and the first subscriber is an IP terminal (the packet network is the Internet and thus the terminal connected to it is an IP terminal (see pages 2 and 3));

wherein the first subscriber sets up a voice connection to a second subscriber (the H.323 standardized protocol is used for setting up voice calls through the Internet (see pages 2 and 3)).

wherein the second signaling information is transmitted using signaling packets of the packet-switching communications network, and wherein the first signaling information is transmitted using a data area of the signaling packets which does not contain any second signaling information (the terms 'data area' taken broadly can merely mean bit position in a packet and since any one bit position can only hold one bit, that bit must be related to either the first or second signaling bits that are being converted by the gateway and thus inherently the signaling bits of one are not in the data area of the other).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5,9,15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA.

Referring to claims 5 and 9, APA discloses the system discussed above. APA does not disclose that the second signaling information corresponds to a SIP signaling protocol nor does the APA disclose that the signaling between the subscribers uses the tunneling principle. However, as pointed out in the specification on page 6, SIP is an established standard and tunneling is also an established communications standard. Thus, it would have been obvious to one skilled in the art at the time of the invention to implement SIP and tunneling in the APA

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because doing so would reduce production costs since SIP and tunneling are already established standards.

Referring to claims 15 and 16, APA discloses the system discussed above. APA does not disclose that the first subscriber is administered as a subscriber with one of an ISDN basic access and a broadband ISDN access in the network element and that the ISDN access is one of an ISDN access in point-to-point configuration and an ISDN access in point-to-multipoint configuration. However, ISDN and this configuration are established standards. Thus, it would have been obvious to one skilled in the art at the time of the invention to implement this standard in the APA because doing so would reduce production costs.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Klagofer et al. (USPN 6,466,662), hereafter referred to as Klagofer.

Referring to claims 7 and 8, APA discloses the system discussed above. APA does not disclose that a feature is provided to the subscriber that cannot be used by the second signaling information nor does it disclose any particular feature. However, Klagofer discloses a system wherein at least one service or feature which cannot be used by the second signaling information is made available for use to the first subscriber via the first signaling information (a call transfer procedure cannot normally be performed using H.323 related signaling (see column 1)) and the service or feature is at least one of call pick-up, call divert, call forwarding, call name display, subscriber cut-in, subscriber-dependent ringing, three-way conferencing, large-scale conferencing, holding, displaying of toll information, a closed user group, a private call number schedule, call number identification, automatic callback when busy, automatic callback when no

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reply, call barring, call waiting and call transfer (the feature is a call transfer feature (see column 1)).

7. Claim 13, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Swartz et al. (USPN 6,330,244), hereafter referred to as Swartz.

Referring to claim 13, APA discloses the system discussed above. APA does not disclose that the first subscriber in the network element assumes the functions of one of a main line and an extension. However, Swartz discloses a system wherein line extensions are used to implement PBX functions over the H.323 protocol (see columns 11 and 12)). It would have been obvious to one skilled in the art at the time of the invention to implement this feature into the APA because doing so would make the system more flexible by using extensions and would also allow the system to cooperate with existing PBX systems thereby making the system more versatile.

### ***Conclusion***

8. The following prior art, which is made of record and not relied upon, is considered pertinent to applicant's disclosure:

- a. U.S. Patent Number 6,314,284 to Patel et al.
- b. U.S. Patent Number 6,738,390 to Xu et al.
- c. U.S. Patent Number 6,707,797 to Gardell et al

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Odland whose telephone number is (571) 272-3096. The examiner can normally be reached on Monday - Friday from 8am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou, can be reached at (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

deo

November 29, 2004



JOHN PEZZLO  
PRIMARY EXAMINER